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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/403,224	10/15/1999	KOJI MATSUMOTO	0020-4621P	6995

7590

04/02/2003

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EXAMINER

WILSON, DONALD R

ART UNIT

PAPER NUMBER

1713

DATE MAILED: 04/02/2003

16

Please find below and/or attached an Office communication concerning this application or proceeding.

46

Office Action Summary	Application No. 09/403,224	Applicant(s) MATSUMOTO ET AL.	
	Examiner D R Wilson	Art Unit 1713	

-- The MAILING DATE of this communication appears on the cover sheet with the corresponding address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 2/19/03.
- 2a) ☐ This action is **FINAL**.
- 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-12 is/are pending in the application.
- 4a) Of the above claim(s) 11 and 12 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9 and 10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) ☒ All b) ☐ Some * c) ☐ None of:
 - 1. ☐ Certified copies of the priority documents have been received.
 - 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Response to Restriction Requirement

1. Applicant's election with traverse of the inventions of Group II, Claims 9-10, in Paper No. 15 is acknowledged. The traversal is on the ground(s) that "[I]f the process is found to be novel, then any product made from the novel process is also novel." This is not found persuasive because it is well established that just because a process is found to be allowable, it does not follow that any product from that process would also be allowable.

When the prior art discloses a product which reasonably appears to be either identical with or only slightly different than a product claimed in a product-by-process claim it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon applicant to provide clear and convincing factual evidence that the respective products do in fact differ in kind - *In re Brown*, 59 CCPA 1063, 173 USPQ 685 (1972); *In re Fessman*, 180 USPQ 324 (CCPA 1974) - and to come forward with evidence establishing unobvious differences between the claimed product and the prior art product. *In re Marosi* 218 USPQ 290.

2. Applicant's reference to *Atlantic Thermoplastic Co. v. Faytex Corp.*, is misplaced as it is a completely different fact situation. Read in its entirety it is clear that the opinion supports that a product-by-process claim is a product claim, not a process claim, and that adding process limitations to an old product does not make the product patentable.

3. The requirement is still deemed proper and is therefore made FINAL. Claims 11-12 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention.

4. Claims 9-10 are under consideration.

Previously Cited Statutes

5. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action

Claim Rejections - 35 USC § 102(b) - 35 USC § 103

6. Claim 9 is under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over WO'995, Takemoto, or Albano. WO'995 is an equivalent to JP'878.

Art Unit: 1713

7. WO'995 discloses processes for making molded products such as are instantly claimed, e.g., see Claim 1, page 4, lines 10-17, and the examples. WO'995 specifically discloses the use of t-butyl cumyl peroxide and dicumyl peroxide (page 3, lines 9-13), and the use of 0.3 parts by weight (pbw) of the peroxide is also specifically taught (page 3, lines 17-19, and Claim 4). The use of peroxide in amounts of 0.5 and 1 pbw is exemplified in Examples 1 and 2. Thus, one would have readily envisaged the use of t-butyl cumyl peroxide or dicumyl peroxide in amounts of 0.3, 0.5 and 1.0 pbw in the compositions of WO'995.

8. Tatemoto discloses elastic fluorine containing polymers comprising bonded iodine which can be cross-linked (col. 1, lines 22-45, col. 6, line 60-66). The iodine content is preferably 0.01 to 5 wt.% (col. 1, lines 51-58). It is taught that the fluorine-containing polymers can be used as a component of a molding material (col. 6, line 66 to col. 7, line 4), which makes molding the material and simultaneously cured readily envisioned by one of ordinary skill in the art. Specific examples of the cross-linking agent include di-t-butylperoxide, t-butylcumylperoxide and dicumylperoxide (col. 4, line 62 to col. 5, line 10), and the preferable use of 0.5 pbw is specifically taught (col. 5, lines 24-26). Thus, one would have readily envisaged the use of di-t-butylperoxide, t-butyl cumyl peroxide or dicumyl peroxide in amounts of 0.5 pbw in the compositions of Tatemoto. The inclusion of 0.1 to 10 parts by weight of polyfunctional unsaturated compounds is also specifically disclosed (col. 5, lines 11-26).

9. Albano discloses curable fluoroelastomer compositions of fluoroelastomers containing preferably 0.01 to 2.5 wt.% of iodine (col. 1, lines 57-64, col. 4, lines 64-66).. Curing with di-t-butylperoxide, and dicumylperoxide is specifically disclosed (col. 4, line 66 to col. 5, line 6), and the use of 0.5 and preferably 1 % by weight is specifically taught (col. 2, lines 54-56). Thus, one would have readily envisaged the use of di-t-butylperoxide, or dicumyl peroxide in amounts of 0.5 and 1.0 wt.% in the compositions of Albano. The inclusion of 0.1 to 1 wt.% of polyfunctional unsaturated compounds is also specifically disclosed (col. 5, lines 7-18). Use of the compositions in making gaskets and seal rings (e.g., Claim 14), makes molding and simultaneous curing readily envisioned by one of ordinary skill in the art.

10. The compositions of WO'995, Tatemoto and Albano prior to undergoing any secondary curing are made by the same process as is instantly claimed. Therefore, prior to undergoing secondary curing, it is

Art Unit: 1713

reasonable to assume that they meet any limitations of decomposition products and contribution of compression set due to secondary curing.

It has been held that where applicant claims a composition in terms of function, property or characteristic where said function is not explicitly shown by the reference and where the examiner has explained why the function, property or characteristic is considered inherent in the prior art, it is appropriate for the examiner to make a rejection under both the applicable section of 35 USC 102 and 35 USC 103 such that the burden is placed upon the applicant to provide clear evidence that the respective compositions do in fact differ. *In re Best*, 195 USPQ 430, 433 (CCPA 1977); *In re Fitzgerald et al.*, 205 USPQ 594.

11. **Claim 10 is rejected under 35 U.S.C. 103(a) as obvious over Tatemoto.**

12. The teachings of Tatemoto have been discussed above. Relevant to Claim 10, Tatemoto also teaches primary curing at 170°C for 10 minutes under both an atmospheric pressure as well as a pressure of 50 Kg/cm² (Example 2), with little if any change in resulting properties as a result in the pressure used as evidenced by Table 1. As the peroxides used are taught to be equivalent to include di-t-butylperoxide, t-butycumylperoxide and dicumylperoxide, similar curing conditions would have been expected to be operable. As the reference teaches no significant change in properties as a result of the different pressure used, it would have been considered obvious to one of ordinary skill in the art to employ any pressure between atmospheric and 50 Kg/cm² with an expectation of equivalent results.

13. **Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over WO'995, Tatemoto, or Albano, as applied to claim 9 above, and further in view of Admissions by Applicant.**

14. Applicant admits that the primary curing conditions of conventional rubbers is for example 0.1 to 1 hour in a range between 150 and 190°C at a pressure of 0.1 to 10 Pa (specification page 5, lines 7-17), which are the curing conditions set forth in instant Claim 10. It would have been obvious to one of ordinary skill in the art to use conventional curing conditions as set forth in the Admissions by Applicant for the primary curing of the compositions of WO'995, Tatemoto, or Albano.

Future Correspondence

Any inquiry concerning this communication or earlier communications from the examiner should be directed to D R Wilson whose telephone number is 703-308-2398.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on 703-308-2450. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311

Art Unit: 1713

for After Final communications. The unofficial direct fax phone number to the Examiner's desk is 703-872-9029.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 308-2351.

A handwritten signature in black ink, appearing to read 'DRW', with a stylized flourish extending to the right.

D R Wilson
Primary Examiner
Art Unit 1713